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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,792	09/27/2005	Markus Schmid	12810-00129-US1	5650

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EXAMINER	
THEODORE, MAGALI P	

ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
05/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,792	SCHMID ET AL.	
	Examiner	Art Unit	
	Magali P. Théodore	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment filed February 23, 2009 was received.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 1-2, 5, 8-12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by **Ciba-Geigy** (GB 1,389,238).

Regarding **claim 1**, Ciba-Geigy teaches a process for the preparation of condensed resins in powder form, wherein the condensation of at least one crosslinkable starting material which is liquid or dissolved in a liquid phase with at least one aldehyde (p 1 ln 72-76) is carried out in a spray reactor (p1 ln 39).

Regarding **claim 2**, Ciba-Geigy teaches that the condensation is carried out within the range of 20 ºC to 150 ºC (p 8 ln 68-70).

Regarding **claim 5**, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

Regarding **claims 8-9**, Ciba-Geigy teaches a mean particle diameter between 50 and 300 microns (p 5 ln 120-122).

Regarding **claim 10**, Ciba-Geigy teaches that the starting materials are mixed prior to spraying and are kept at within a range between -40 ºC to 30 ºC (p 8 ln 57-58).

Regarding **claim 11**, Ciba-Geigy teaches that wherein the starting material used is melamine (p 1 ln 47) or urea (p 8 ln 54).

Regarding **claim 12**, Ciba-Geigy teaches that the aldehyde used is formaldehyde (p 8 ln 56).

Regarding **claim 18**, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

Claim Rejections - 35 USC § 102/103

Claims 13-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Ciba-Geigy**.

Regarding **claim 13**, Ciba-Geigy teaches a condensate (p 8 ln 69).

The disclosed product of Ciba-Geigy and the instantly claimed product appear to be essentially the same, comprised of the same components, and used in the same manner. In the event any differences can be shown for the product of the product-by-process claim 13 as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Regarding **claim 14**, Ciba-Geigy teaches a condensate (p 8 ln 69). The examiner recognizes that the claimed moisture content is not positively stated by the reference. However, since the reference discloses all of the claimed ingredients,

process steps and process conditions, the claimed moisture content would inherently be achieved by carrying out the disclosed process. If it is Applicant's position that this would not be the case: (1) evidence would need to be presented to support applicants' position; and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by carrying out only these steps.

In the event any differences can be shown for the product of the product-by-process claim 14 as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Claim Rejections - 35 USC § 103

Claims 3, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ciba-Geigy** as applied to claim 1 above and further in view of Thiesse et al. (US 5,807,584), henceforth **Thiesse**.

Regarding **claim 3**, Ciba-Geigy does not teach a nozzle size. However, Thiesse establishes nozzle size as a result effective parameter by teaching that the nozzle diameter is always smaller than the size of the particle it makes. Therefore it would

have been obvious to one of ordinary skill in the art to optimize the size of the orifice in Ciba-Geigy's method because Thiesse teaches that the size of the nozzle determines the size of the particle formed. Optimizing a result-effective parameter known in the art does not impart patentable distinction to an invention. See MPEP 2144.05 [R-5] II, in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding **claim 15**, Ciba-Geigy does not teach a nozzle size. However, Thiesse establishes nozzle size as a result effective parameter by teaching that the nozzle diameter is always smaller than the size of the particle it makes. Therefore it would have been obvious to one of ordinary skill in the art to optimize the size of the orifice in Ciba-Geigy's method because Thiesse teaches that the size of the nozzle determines the size of the particle formed. Optimizing a result-effective parameter known in the art does not impart patentable distinction to an invention. See MPEP 2144.05 [R-5] II, in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding **claim 19**, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

Claims 4, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ciba-Geigy** as applied to claim 1 above and further in view of Levendis et al. (US 5,269,980), henceforth **Levendis**.

Regarding **claim 4**, Ciba-Geigy teaches does not teach drops *per se*. However, Levendis teaches that doing the condensation in individual drops produces particles of predictable shape and size (col 1 ln 45-49). Therefore it would have been obvious to

one of ordinary skill in the art to use drops in the method taught by Ciba-Geigy because Levendis teaches that this produces particles of uniform shape and size.

Regarding **claim 16**, Ciba-Geigy teaches does not teach drops *per se*. However, Levendis teaches that doing the condensation in individual drops produces particles of predictable shape and size (col 1 ln 45-49). Therefore it would have been obvious to one of ordinary skill in the art to use drops in the method taught by Ciba-Geigy because Levendis teaches that this produces particles of uniform shape and size.

Regarding **claim 20**, Ciba-Geigy teaches that the condensation is carried out in the presence of a dry accompanying gas (p 5 ln 36-37).

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ciba-Geigy**.

Regarding **claim 6-7**, Ciba-Geigy does not specify the pressure at condensation. However, Ciba-Geigy establishes pressure as a result effective parameter by teaching that pressure affects the dispersion and secondary agglomeration of the droplets (p 5 ln 73-75). Therefore it would have been obvious to one of ordinary skill in the art to optimize the size of the pressure in Ciba-Geigy's method because Ciba-Geigy teaches that pressure determines the droplets' dispersion and secondary agglomeration. Optimizing a result-effective parameter known in the art does not impart patentable distinction to an invention. See MPEP 2144.05 [R-5] II, in re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ciba-Geigy** in view of **Thiesse** as applied to claim 3 above, and further in view of **Levendis**.

Regarding **claim 17**, Ciba-Geigy teaches does not teach drops *per se*. However, Levendis teaches that doing the condensation in individual drops produces particles of predictable shape and size (col 1 ln 45-49). Therefore it would have been obvious to one of ordinary skill in the art to use drops in the method taught by Ciba-Geigy because Levendis teaches that this produces particles of uniform shape and size.

Response to Arguments

Applicant's arguments filed February 23, 2009 have been fully considered but they are not persuasive.

Applicant argues that Ciba-Geigy suggests that the condensation reaction involving the aldehyde takes place not in the spray reactor but in the flask where the precondensates are made. In response to Applicant's argument, Ciba-Geigy teaches that the process is called "spray condensation" because "the condensation process is usually completed by the spray drying" (p1 ln 35-39). Even though the condensation may begin in the flask, the reaction takes place in part in the spray reactor.

Applicant argues that Ciba-Geigy does not teach or suggest that the surface-active agents react with an aldehyde. In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., the reaction of surface-active agents with an aldehyde) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Levendis does not teach a condensation reaction with an aldehyde within a spray reactor or between an aldehyde and a crosslinkable starting material. In response to Applicant's argument, Ciba-Geigy and Levendis is relied upon to teach that the condensation takes place in a spray reactor.

Applicant argues that Levendis teaches away from "the claimed subject matter" by teaching the use of prepolymers such and not conducting the entire polymerization in a spray reactor. Since the recitations that constitute "the claimed subject matter" are not specified, the examiner has read Applicant's argument to refer to the condensation reaction's taking place in a spray reactor. In response to Applicant's argument, it is not necessary for the *entire* polymerization to take place in a spray reactor for the claim limitation as written to be met. If part of the reaction takes place in the spray reactor, then the reaction is carried out in a spray reactor as claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magali P. Théodore whose telephone number is (571) 270-3960. The examiner can normally be reached on Monday through Friday 9:00 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Magali P. Théodore/
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791